



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,670	08/31/2001	Brad Pivar	7207-211	1117

26263 7590 07/26/2007
SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
----------	--------------

2165

MAIL DATE	DELIVERY MODE
-----------	---------------

07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/943,670

Applicant(s)

PIVAR ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9, 11-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-7, 9, 11-24, and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/12/2006 & 5/4/2007.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Remarks

1. The Amendment filed on May 4, 2007 has been received and entered. Claim 26 is newly added. Therefore, claims 2-7, 9, 11-24, and 26 are now pending.
2. Applicant's Amendment has overcome the previous rejections under 35 USC 112, second paragraph, and previous claim objections.

Information Disclosure Statement

3. The information disclosure statements (IDSs) submitted on Sept. 12, 2006 and May 4, 2007 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Claim Objections

4. Claims 18, and 20-24 are objected to because of the following informalities:

Applicant's newly amended claimed language of "computer code that provides for" raises the interpretation under MEPE 2106 [II-C] and MPEP 2173.02 [R-3] to intended use language not actually performing the functionality it set out to be. The Examiner had suggested to either maintain writing the claimed limitations as they were using present tense verbs (i.e. receiving ...performing... sending") or change the tense to "that performs...that receives... that sends" etc. In fact, the way they are written now (i.e. that provides for the generation", lack antecedent basis. Correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 2-7, 9, 11-24, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et al. (U.S. Patent No. 6,796,489).

As to claims 9, 11, and 18, Slater et al. discloses a system for interactive processing of a document comprising:

- a storage device (See Figure 1, shows storage devices);
- a processor connected to the storage device and to a first and second user on a computer network (See Figure 1, shows a computer connected to wide area network);
- a timing device connected (inherent processor clock in any computer) to the processor;
- the storage device storing a program to control the processor (See Figure 1, shows storage devices, 21, processing unit); and
- the program including instructions that direct the processor to control the:
 - sending of at least one request determined from a selected document to a first user at a first location on a computer network (Sere column 9, lines 25-40);

Art Unit: 2165

receiving of at least one response to the at least one request from the first user (See column 9, lines 25-40);

writing of information obtained from the at least one response from the first user to at least one digital file (See column 9, lines 45-53);

determining of a first time stamp from the timing device corresponding to the receipt of the at least one response from the first user to the at least one request (See column 8, lines 24-50);

performing of a first digital signature routine on the at least one digital file to obtain an original digital signature (See column 8, lines 24-50);

recording of the first time stamp and first original digital signature associated with the at least one digital file in a database (See column 8, lines 24-50, also see Figure 3A, shows both signature on the document stored as a record in Database);

sending of at least one request determined from the selected document to a second user at a second location on a computer network (See column 10, lines 34-50);

receiving of at least one response from the second user to the at least one request (See column 3, lines 13-16);

writing of information obtained from the at least one response from the second user to at least one digital file (See column 3, lines 13-16);

performing a second digital signature routine on the at least one digital file to obtain a second digital signature of the at least one digital file (See column 10, lines 51-59); and

creating a second timestamp corresponding to a second time of submission of the information obtained from the at least one response from the second user (See column 13, lines 30-37, all digital signatures are stored with timestamp); and

sending the second digital signature and the second time stamp to a second remote location (See column , lines , both signature and time stamp are part of the digital document now that is being returned to the originator).

As to claims 2, 12, and 19, Slater et al. discloses wherein the computer network is the Internet (See column 6, line 57).

As to claims 3, 13, and 20, Slater et al. discloses further comprising to determine whether the at least one response from the user to the least one request is valid and sending at least one additional request to the first user for additional information when the at least one response from the first user is invalid (See column 3, lines 13-16, wherein “valid” reads on “verification”).

As to claims 4, 14, and 21, Slater et al. discloses further comprising to determine whether the at least one response from the second user to the at least one request is valid and sending at least one additional request to the second user for additional information when the at least one response from the second user is invalid (See column 16, lines 25-59, wherein if document is not valid or completed, more information can be requested from any user for recordation).

As to claims 5, 15, and 22, Slater et al. discloses further comprising to perform a routine determined from the selected document to provide feedback to the first user, the feedback determined in part by the at least one response from the first user to the at least one request (See column 10, lines 34-50).

As to claims 6-7, 16-17, and 23-24, Slater et al. discloses further comprising to perform a routine determined from the selected document to provide feedback to the second user, the feedback determined in part by the at least one response from the second user to the at least one request (See column 16, lines 25-59, wherein if document is not valid or completed, more information can be requested from any user for recordation).

As to claim 26, Slater et al. discloses wherein the first remote location is the same as the second remote location (See column 3, lines 14-17, wherein if the first and second location are the same then the document is just routed back to the originator or to a server where it was stored).

Response to Arguments

7. Applicant's arguments filed May 4, 2007 have been fully considered but they are not persuasive.

In response to Applicant's argument in various parts that "Slater et al. does not teach or suggest providing at least one request to a first user...and in turn receiving a response... nor

sending any request to a second user at a second location” is acknowledged but not deemed to be persuasive.

Slater’s invention is directed to creating and routing digitally signed documents. The mere present of document forms to be populated by a first user and second user clearly suggest the requirement of a request to sign the document. Once first user signs (i.e. response) then the document is automatically routed to second destination (i.e. second user) prompting them for their signature. Any field on an electronic form is a placeholder (requesting information) and user’s entry (is a response to request. Furthermore, Slater in column 9, lines 51-55 explicitly teach querying the user for information. If you are part of parties involved in the transaction requiring your signature then you are receiving the digital file to be signed (i.e. request) and fulfilling the request by signing it thus broadly interpreted to read on the argued limitations.

In response to Applicant’s argument in various parts that “Slater et al. does not give any explanation as to how a digital signature is created or attached to an electronic file” is acknowledged but not deemed to be persuasive.

The Examiner contends that neither do the claims. In fact, the Applicant’s specification page 19, specifically attest to the fact that signature routines are well known in the art and any type can be applied in the Applicant’s invention.

Furthermore, Slater et al. in column 7, lines 15-49 teaches the process involved in creating, applying, and validating his signature routine.

In response to Applicant's argument in various parts that "Slater et al. does not teach or suggest a database...the only database disclosed in Slater is discussed in column 15, lines 17-31, which stores electronic documents" is acknowledged but not deemed to be persuasive.

Slater clearly teaches storing the electronic document in a database as acknowledged in applicant's response that same document includes the embedded signature with the time stamp and furthermore, Slater also teaches in column 17, lines 7-18, that an audit log stores signature and timestamp information. Thus, broadly interpreted to read on the argued limitation. Audit log stores data records and are searchable.

In response to Applicant's argument that "Slater et al. does not teach or suggest a timing device" is acknowledged but not deemed to be persuasive.

Applicant's specification does not give specific meaning to the term "timing device" in fact pages 19 and 20 of Applicant's specification states the server maintains a master clock that conforms to any time desired criteria. Thus, as it is well known in the art that any computer/processor inherently contain a clocking device. More explicitly as taught in Slater column 11, lines 25-45, timestamps are generated inherently by clock/timing device.

In response to Applicant's argument that "Slater et al. does not teach or suggest sending at least one additional request to the first user for additional information when the at least one response from the first user is invalid" is acknowledged but not deemed to be persuasive.

As the Applicant is responsible for the reference as whole, and although the cited portion deals with recite back to the originator thus indicating the completeness of the second user

signing the document, Slater in column 16, lines 39-42, and column 16, lines 53-58 teaches the process of validation and verification which includes returning the documents back to the originator (inherently for additional action to be taken). It is well known in the art of electronic forms that verification and validation occurs on the fields of the document before it record or sent.

In response to Applicant's argument that "Slater et al. does not teach or suggest writing information obtained from a response form a second user to a digital file" is acknowledged but not deemed to be persuasive.

Slater's system is collecting signatures of at least two users thus broadly interpreted to initiate a request (i.e. data field for entry of signature) by routing the document the second user for the signature. A prompt to fill out data in a form is in fact well known in the art to be a request. Receiving the signature is the response and the actually entry and embedding of the digital signature in the document is the writing of the response to the digital file.

In response to Applicant's argument that "Slater et al. does not teach or suggest feedback determined in part by the at least one response to the at least one request received from the fist user" is acknowledged but not deemed to be persuasive.

The originator of the signature once receiving the acknowledgment reacts either by validating or invaliding the signature thus in fact a receipt is a feedback to acknowledge the request. Slater in column 3, lines 10-17, teaches the receipt to be delivered to the originator thus completing the loop. The claims don't suggest a different functionality to the feedback

mechanism. If the additional information is used in completing a firm or validating the signature, it should be stated as such in the claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Niveen Abel-Jalil', with a long horizontal flourish extending to the right.

Neveen Abel-Jalil
July 23, 2007